

Applicants: David M. Stern et al.  
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REMARKS

Claims 1-3 and 5-7 are pending and under examination in the subject application. Applicants have amended claims 1, 2 and 5 to more distinctly point out what applicants consider their invention. Therefore, applicants maintain that these amendments raise no issue of new matter. Applicants also herein cancel claims 3 and 7 without prejudice or disclaimer. Accordingly, claims 1, 2, 5 and 6 will be pending in the subject application upon entry of this Amendment.

Rejection under 35 U.S.C. §112, First Paragraph

The Examiner rejected claims 1-3 and 6-8 under 35 U.S.C. §112, first paragraph, as allegedly not enabling a person skilled in the art to which it pertains to make and use the invention commensurate in scope with the claims

Specifically, the Examiner states that the specification is enabling for a transgenic mouse whose genome comprises a DNA sequence comprising a nerve tissue specific promoter operatively linked to a DNA sequence encoding ABAD and a nerve tissue specific promoter operatively linked to an alternatively spliced hAPP mini-gene that encodes hAPP695, hAPP751 and hAPP770, comprising one or more familial Alzheimer's disease mutants, and methods of using the mice to evaluate therapeutic treatments. However, the Examiner alleges that the specification is not enabling for other transgenic nonhuman animals comprising separate DNA sequences encoding

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hAPP695, hAPP751 and hAPP770, and methods of evaluating using the transgenic nonhuman animal.

In response, and without conceding the correctness of the Examiner's rejection, applicants note that claims 3 and 7 have been canceled by this Amendment. Accordingly, the Examiner's rejection of those claims is now moot. Additionally, applicants note that independent claims 1 and 5, and dependent claims 2 and 6, as amended, provide a transgenic mouse and related methods, respectively. Applicants maintain that the invention of claims 1, 2, 5 and 6 is that which the Examiner has conceded is enabled by the specification.

The Examiner also rejected claims 1-3 and 6-8 under the enablement portion of 35 U.S.C. §112, first paragraph, for allegedly improperly incorporating subject matter by reference.

Specifically, the Examiner alleges that the applicants' amendment to the specification in response to the improper incorporation by reference rejection made in the September 24, 2002 Office Action is impermissible. The Examiner alleges that (1) applicant did not identify specific portions of the referenced document where the subject matter being incorporated may be found, and (2) applicant did not include an affidavit or declaration executed by applicant or practitioner as required by M.P.E.P. 608.01(p).

In response to the Examiner's rejection, but without conceding the correctness thereof, applicants note that claims 3 and 7 have been canceled by this Amendment. Accordingly, the Examiner's rejection

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of those claims is now moot.

In response to the Examiner's rejection of claims 1, 2, 5 and 6, and further to the March 25, 2004 telephone conference between Examiner Deborah Crouch and Alan J. Morrison, Esq., applicants attach hereto a declaration (**Exhibit A**) signed by the undersigned attorney as required by M.P.E.P. 608.01(p). Accordingly, applicants maintain that their August 25, 2003 Amendment adding subject matter from Hsia et al. into the specification is in accord with the provisions of 35 U.S.C. §112, first paragraph and M.P.E.P. 608.01(p).

Applicants assert that the amended claims satisfy the requirements of 35 U.S.C. §112, first paragraph, and respectfully request that the Examiner reconsider and withdraw this rejection.

**Summary**

Applicants maintain that the pending claims are in condition for allowance. Accordingly, applicants respectfully request allowance of the pending claims.

No fee, other than the \$55.00 fee for a one-month extension of time, is deemed necessary in connection with the filing of this Amendment. However, if any additional fee is required, authorization is hereby given to charge the amount of such fee to Deposit Account No. 03-3125.

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If a telephone interview would be of assistance in advancing the prosecution of the subject application, applicants' undersigned attorneys invite the Examiner to telephone them at the number provided below.

Respectfully submitted,



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Date  
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